Office-Supreme Court, U.S.
FILED
FEB 23 1983
ALEXANDER L. STEVAS,
CLERK

No. 82-1223

SUPREME COURT OF THE UNITED STATES

October Term, 1982

MINNESOTA MINING AND MANUFACTURING COMPANY,
Petitioner,

vs.

WALTER S. BLUME and THE ELECTRODYNE COMPANY, INC.,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF FOR THE RESPONDENTS

JOHN D. FAIRCHILD
Counsel of Record

CONNOLLY, BOVE, LODGE & HUTZ
1800 Farmers Bank Building
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141

CHARLES G. ATKINS
STRAUSS, TROY AND RUEHLMANN Co., L.P.A.
2100 Central Trust Center
Cincinnati, Ohio 45202
(513) 621-2120

Attorneys for Respondents

February 18, 1983

COURT INDEX PRESS, INC. — 215 E. Ninth Street, Cincinnati, Ohio 45202 — (513) 241-1450

QUESTIONS PRESENTED

I. Whether the inventor-assignor of a patent, the ownership of which is subsequently acquired by another from the patent assignee, may challenge the validity of the patent in a suit for infringement brought against him by the owner, for the benefit of himself and the general public, on the basis of prior art which did not come to the inventor's attention until long after the owner had acquired the patent.

II. Whether the record supports the twice considered and abundantly documented findings of fact by the trial court that it was "established overwhelmingly" by three "credible" witnesses that all the subject matter as a whole of claims 8-10 of the patent at bar were obvious from and indeed fully disclosed by the prior art to a person having ordinary skill in the art to which said subject matter pertains at the time the alleged invention was made, and the legal conclusion that those patent claims accordingly are invalid, pursuant to 35 U.S.C. 103.

TABLE OF CONTENTS

	page
QUESTIONS PRESENTED	1
TABLE OF CONTENTS	III
TABLE OF AUTHORITIES	IV
OPINIONS	1
JURISDICTION TO REVIEW IN THIS COURT	2
STATUTE INVOLVED	2
STATEMENT OF THE CASE	3
I. Estoppel, Question of Fact	3
– i) Blume Did Not Sell Patents to 3M	3
– ii) Patent Denounced Worthless After Date of Issue	4
– iii) All Aspects of Estoppel Considered Below	5
II. Obviousness Supported By The Record	7
– i) Claims Dissolved By Prior Art	7
– ii) Merits Of Different Invention Not Relevant	8
ARGUMENT	9
CONCLUSION	11
APPENDIX	1a-7a
– Supplementary Order Of District Court Rejecting Petitioner's Pre-Appeal Motion To Amend Judgment, Filed March 25, 1980	

TABLE OF AUTHORITIES

Cases

page

Brand Plastics Co. v. *Dow Chemical Co.* (C.D. Cal. 1967), 267 F. Supp. 1010, at 1013 6

Dickerson v. *Colegrove* (1880), 100 U.S. 578 ....6, 10

Graham v. *John Deere Co.* (1966), 383 U.S. 1....7, 10

Lear, Inc. v. *Adkins* (1969), 395 U.S. 653 .....6, 10

Scott Paper Co. v. *Marcalus Mfg. Co., Inc.* (1945), 326 U.S. 249 6

Westinghouse Co. v. *Formica Co.* (1924), 266 U.S. 342 6

Statutes

28 U.S.C. § 1254 (1) 2

35 U.S.C. § 103 2

No. 82-1223

SUPREME COURT OF THE UNITED STATES

October Term, 1982

MINNESOTA MINING AND MANUFACTURING COMPANY,
Petitioner,

vs.

WALTER S. BLUME and THE ELECTRODYNE COMPANY, INC.,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

BRIEF FOR THE RESPONDENTS

OPINIONS

The invalidity of the patent at bar is addressed on the merits in three separate judicial opinions. Only two of them are reproduced in the Appendix to the petition. For completeness, the third opinion is reproduced as an Appendix to this brief for respondents. To wit:

1. Opinion of the United States Court of Appeals for the Sixth Circuit, affirming invalidity, filed July 7, 1982 (Pet. App. A1-A15);

2. Findings of fact and conclusions of law of the United States District Court for the Southern District of Ohio, deciding invalidity following trial, filed August 7, 1979 (Pet. App. A87-A145); and,

3. Supplementary Order of the same District Court rejecting petitioner's post-decision, pre-appeal motion to amend judgment, filed March 25, 1980 (see Appendix to this Brief For Respondent).

JURISDICTION

The judgment of the Circuit Court was entered on July 7, 1982 (Pet. App. A148-A149); petition for rehearing was denied on October 21, 1982 (Pet. App. A150). The jurisdiction of this Court is invoked under 28 U.S.C. 1254 (1).

STATUTE INVOLVED

35 U.S.C. § 103.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title [35 USCS § 102], if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT OF THE CASE

I. The "Estoppel" Question Is One of Fact And Not Of Law.

The first Question, as proposed by the petitioner, is one of estoppel by sale, but its contorted language underscores the complex factual background which the trial court examined closely. The jurisdiction of the District Court was based upon 28 U.S.C. §§ 1332(a) and 1338(a).

i) Mr. Blume did not sell the patents to 3M for substantial money.

Respondents ("Mr. Blume", where the context permits) made numerous inventions in bonded magnets, before 1967 when he was with the Magnetics Division of the Leyman Corporation. His inventions and the patent rights pertaining to them were routinely assigned to his employer, as is customary. All the Blume patents were owned by the Leyman Corporation, but Mr. Blume was never an owner of that company (Pet. App. A29). Mr. Blume never owned any of these patents which bore his name as inventor.

In 1967 petitioner ("3M") bought the Magnetics Division from Leyman Corporation (not from Mr. Blume, who did not even participate in the negotiations). The Magnetics Division was a going concern with manufacturing facilities, customers, and the like, which 3M bought to get into the bonded magnet business. One asset of the Magnetics Division which 3M acquired from Leyman Corporation was some forty (40) Blume patents (Pet. App. A30-A31), including the two in suit, only one of which petitioner seeks to bring to this Court. Leyman Corporation, which sold the Blume patents to 3M together with the Magnetics Division, thereafter stayed out of the bonded magnet business and never sought to re-enter that business.

Leyman Corporation, the seller to 3M, *never* asserted "after the sale that one of the patents is worthless", as stated in petitioner's first Question (Pet. Br.). Petitioner's attempt to condense the complicated factual background into a question inviting review resulted in this and other unacceptable deviations from the facts of record.

Mr. Blume, the inventor, *never* received "substantial" or any other money from 3M when he assigned the patent rights in his inventions to the Leyman Corporation, his employer. The only money Mr. Blume received from 3M was from the latter's purchase of Mr. Blume's equity in a royalty contract, which had been in effect between Mr. Blume and the Leyman Corporation for many years when 3M acquired the Magnetics Division and the Blume patents from Leyman Corporation (Pet. App. A29). The isolated fact that "$566,800 was paid to the inventor," as recited in petitioner's first Question, is thus irrelevant in its true context – but misleading in the context of petitioner's estoppel by sale Question.

Our purpose is not to criticize petitioner for distorting the record in an attempt to frame a Question which might be of interest to this Court. Our purpose, rather, is to state the relevant essential facts from this tremendously complex record, so that the propriety of petitioner's contentions can be readily judged.

ii) The worthless nature of the patent at bar was discovered later.

This is not a case where the inventor or the seller knew the one patent to be worthless *before* it was sold, but did not tell the buyer, and thus the inventor should be estopped to assert such worthlessness after the sale.

Here, the evidence established and the trial court found that the worthless nature of the patent at bar did not come to Mr. Blume's attention until several years *after* 3M bought the Blume patents from the Leyman Corporation. Before the sale both Mr. Blume and the Leyman Corporation believed the patent in question to be a valid one, and all their actions were in accord with that belief (Pet. App. A114-A117).

The prior art which invalidated the patent at bar was brought to Mr. Blume's attention by 3M, who then owned the patents, several years after the sale. It was brought to his attention, moreover, well *before* 3M later decided to release him to set up The Electrodyne Company to produce and sell bonded magnets covered by the claims of the patent (Pet. App. A116).

The trial court developed all the relevant details of this evidence in its lengthy opinion. It found specificially that an equitable estoppel did not operate to prevent Mr. Blume from asserting invalidity of a patent of which he was the inventor (Pet. App. A124-A125).

iii) All factual and legal aspects of estoppel were considered below.

The District Court recognized that a threshold legal issue was "whether an inventor assignor may attack the validity of his own patent" (Pet. App. A93). The District Court decided to "examine the question independently" even though 3M "appears to consent to permitting Mr. Blume to raise these defenses" (Pet. App. A92).

The latter reference is to the fact that 3M, prior to its petition to this Court, had agreed throughout the litigation that Mr. Blume had the right, under the present day con-

trolling authorities, to assert patent invalidity over the prior art, because of the public interest.

In examining the estoppel question independently, the District Court thoroughly analyzed the law since *Westinghouse Co.* v. *Formica Co.* (1924), 266 U.S. 342, including the doctrine that an inventor-assignor can use prior art to qualify or narrow the claims of his own patent in a suit against him by an assignee of the patent, *Scott Paper Co.* v. *Marcalus Mfg. Co., Inc.* (1945), 326 U.S. 249 (Pet. App. A92-A94).

The District Court properly considered the worthy public policy considerations explained in *Lear, Inc.* v. *Adkins* (1969), 395 U.S. 653, and followed by courts since then, and concluded that "the more recent cases have permitted patentees to attack the validity of their patents based on the overriding public interest in insuring that improper patents be declared invalid" (Pet. App. A94).

The District Court considered the "best discussion" of this issue to be by Judge Gray in *Brand Plastics Co.* v. *Dow Chemical Co.* (C.D. Cal. 1967), 267 F. Supp. 1010, at 1013, who "adopted the more modern rule" — but carefully qualified it with the doctrine of equitable estoppel which developed from *Dickerson* v. *Colgrove* (1880), 100 U.S. 578. The District Court thought this to be the "sensible rule" and adopted it (Pet. App. A95-A96).

Petitioner 3M's reason for granting of writ in respect of its first Question is the inflamatory statement "there is no public interest in protecting the cheat" citing the very same *Dickerson* v. *Colgrove* decision (Pet. Br. 5).

All this — the full facts and the same law — were carefully evaluated by the District Court. Its findings and conclusions on this issue were challenged only peripherally by

petitioner on appeal to the Circuit Court. The latter affirmed the District Court in every respect, without dissent, and without mention of the estoppel issue (Pet. App. A1-A15).

Petitioner did not raise the estoppel issue when it sought rehearing, but in any event no Circuit Judge favored rehearing en banc (Pet. App. A150).

II. The "Obviousness" Question Was Decided On All The Evidence.

The second Question proposed by the petitioner would have this Court re-examine the careful manner in which the courts below found on all the evidence that the subject matter of claims 8-10 of the patent at bar was obvious under 35 U.S.C. 103, and concluded that those claims are invalid.

i) Every element of the claims was disclosed by the prior art.

The main thrust of 3M's argument is that "no ordinary workman testified that the relationship discovered by Blume was to be found anywhere in the prior art" (Pet. Br. 8). The record shows otherwise.

At the trial, three witnesses testified about the subject matter of the patent claims in issue, and what was found in the prior art. All three witnesses actually had ordinary skill in the bonded magnet art at the time the alleged invention was made, and the District Court specifically found all three to be "credible" (Pet. App. A121).

This evidence convinced the District Court, within the guidelines of *Graham* v. *John Deere Co.* (1966), 383 U.S. 1, that "there is no appreciable difference between the dis-

closure of the pertinent prior art and the claims at issue of the patent in suit" (Pet. App. A121-A122), and "defendants have proved by a preponderance of the evidence that the subject matter of claims 8 through 10 of U.S. Patent No. 3,235,675, when compared to the pertinent prior art, was obvious to an individual having ordinary skill in the art in 1954" (Pet. App. A127).

Immediately after the invalidity decision by the District Court, 3M filed a motion for amended judgment asking the District Court to reverse itself and hold the claims valid and infringed, rather than invalid. This gave the District Court a second opportunity to reassess its findings of obviousness and conclusion of invalidity. It decided that 3M's motion was "not well taken" and denied it, emphasizing that it was "established overwhelmingly at trial that the Philips prior art discloses every element of claims 8-10 of the 675 patent" (Resp. Addendum).

The Circuit Court affirmed, without dissent, correctly noting that "Under Section 103, the scope and content of the prior art is a factual matter to be determined by the district court. *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966). Where, as here, the district court chooses to credit the testimony of three expert witnesses as to what the prior art discloses, we cannot say the finding of the district court was clearly erroneous" (Pet. App. A11-A13).

ii) The merits of a different invention are not relevant.

Petitioner concludes by quoting testimony of a witness called by Mr. Blume (Pet. Br. 8-9).

That testimony, however, was about Mr. Blume's invention disclosed and claimed in the *other* Blume patent in

suit – not the patent which 3M seeks to bring to this Court. The District Court specifically found that such evidence about the meritorious nature of the *other* patent to be "inapposite" and "not relevant" to the patent at bar (Pet. App. A124-A127).

ARGUMENT

The foregoing statement shows that petitioner's two Questions are purely factual, and they were decided fairly and unanimously below.

This litigation has been going on for seven years since early 1976. It has involved numerous motions, extensive discovery, two separate trials resulting in lengthy opinions, motions for reconsideration, three consolidated appeals to the Circuit Court, and petitions for rehearing. The immense record covers the activities of the parties and numerous related persons over a period of about 30 years from the early 1950's. Much of the record is highly technical, relating to the development and commercial exploitation of barium ferrite matrix bonded magnets (Pet. App.).

Mr. Blume pioneered the development and commercialization of those magnets at the Leyman Corporation, and is proud of his inventions and the patents which protected them. 3M recognized the value of the business, and bought it and the Blume patents from Leyman Corporation in 1967 (Pet. App. A29).

Several years later, 3M sent to Mr. Blume some prior art which he had not known about before. That prior art disclosed the "novel" subject matter of the key claims (8-10) of the patent at bar (Pet. App. A116). Other companies competing with 3M in the bonded magnet business thereafter infringed those claims openly, but 3M never

enforced the flawed patent at bar against them (Pet. App. A126-A127).

Later Mr. Blume went into the bonded magnet business, on the belief that he had a written patent release from 3M to do so (Pet. App. A50-A59). The District Court later found that belief to be wrong, however, and the Circuit Court affirmed (Pet. App. A72, A7-A8).

Mr. Blume's magnets were made by a "trade secret" process which he had developed to avoid the *other* patent in suit, a patent which he felt was meritorious and the validity of which he never challenged but proudly asserted. The District Court found, however, that his "trade secret" process did not avoid infringing that other patent (now long expired), and again the Circuit Court affirmed (Pet. App. A128-A144, A8-A9).

The patent at bar was different. 3M knew about and subsequently sent to Mr. Blume the invalidating prior art, long after 3M acquired the Blume patents from Leyman Corporation. When 3M included that discredited patent in this suit for infringement, Mr. Blume had no choice but to challenge it. He did so successfully. The District Court held the key claims 8-10 invalid over the prior art mentioned above, and the Circuit Court affirmed and denied rehearing — resulting in 3M's petition to this Court.

In this context, 3M's petition is nothing more than a final effort to resurrect a fatally flawed patent. Mr. Blume was never estopped — factually or legally — from attacking validity, consistent with *Lear* v. *Adkins* and *Dickerson* v. *Colgrove*. The courts below found the patent claims to be obvious in view of the prior art, under the guidelines laid down by *Graham* v. *John Deere*, and properly concluded that they were invalid.

CONCLUSION

The Questions raised by petitioner are complex, but purely factual. The decisions below do not conflict with rules adopted in other circuits, and they do not purport to set any precedent, important or otherwise. This is a private civil dispute, with no social implications. The petition for a writ of certiorari accordingly should be denied.

Respectfully submitted,

JOHN D. FAIRCHILD
Counsel of Record

CONNOLLY, BOVE, LODGE & HUTZ
1800 Farmers Bank Building
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141

CHARLES G. ATKINS
STRAUSS, TROY AND RUEHLMANN CO., L.P.A.
2100 Central Trust Center
Cincinnati, Ohio 45202
(513) 621-2120

Attorneys for Respondents

APPENDIX

Supplementary Order of the United States District Court for the Southern District of Ohio rejecting motion to amend judgment, filed March 25, 1980.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION

No. C-1-76-51

MINNESOTA MINING AND MANUFACTURING COMPANY,

Plaintiff,

v.

WALTER S. BLUME, et al.,

Defendants.

ORDER

(Filed March 25, 1980)

Plaintiff (3M) has filed a motion under Rule 52(b), Federal Rules of Civil Procedure, for additional findings, amendment of findings and amendment of judgment (doc. 165). This is supported by memorandum attached to the motion. There is a lengthy memorandum in opposition (doc. 170), to which the plaintiff has made a reply (doc. 175). Hence, the motion is submitted for decision under the local rule governing the processing of motions (3.5.2).

Minnesota Mining and Manufacturing Company requests two findings in addition to those included in the Court's findings of fact and conclusions of law (doc. 164). 3M also requests amendment to the Court's findings in five respects, and an amendment of the judgment order in accordance with its proposed additional and amended findings to conclude that claims eight through ten of U.S.

Patent No. 3,235,675 are valid and literally infringed by defendants' products. After consideration, we find the motion not well taken, and it is, therefore, denied.

Central to 3M's argument is the claim that it is not enough that the Zeitschrift article says that the particles described are plate-like as found by this Court (findings of fact and conclusions of law, pp. 31-32), the record must contain an "enabling disclosure," a description of how to make them for it to be established as prior art, citing *Tee-Pak* v. *St. Regis Paper Company*, 491 F. 2d 1193 at 1196 (6th Cir. 1974) and other cases (doc. 165, p. 2). *Tee-Pak* only discusses novelty and not obviousness. Of course, novelty, utility and nonobviousness are the three elements of patentability and are sometimes confused.

We agree with the defendants that they established overwhelmingly at trial that the Philips prior art discloses every element of claims 8-10 of the 675 patent (doc. 170, p. 6, *et seq.*).

We reject 3M's contentions that its rebuttal testimony *requires* that the Court amend its findings and conclusions. In connection with what 3M says about the failure of its test for trial to produce plate-like particles by following the teachings of the Philips prior art, it is noteworthy that in that test at least some of the particles produced were plate-like. Also, there was no indication of the amount of ingredients used in 3M's test for trial (tr. 1236, 1245, 1246, 1248). Defendants argue the total amount is critical for the success of the process and to change the total amount of ingredients, even though the proper proportions are maintained, will require an entirely different process if the same end product is to be attained (doc. 170, p. 9, *citing* tr. 649).

We did and do find that the Philips prior art and the

record herein show how the platelets of the requisite configuration can be made. There is no dispute that the Philips prior art discloses knowledge of the platelets. (By the Philips prior art we are referring to the Zeitschrift article and the 778 Philips patent.)

Even if we agreed with 3M that the record is deficient in not containing an enabling disclosure, the result would be the same for the following reasons:

The invention under consideration is that set forth in claims 8-10 (which are set out in our findings of fact, etc., doc. 164, p. 5). It is for permanent magnet material comprising platelets in a nonmagnetic matrix or binder or molded binder. The claimed invention is not the platelets themselves (though that is all that was novel in the invention). Nevertheless, 3M talks about an absence in the record of a method for making one element of the invention, namely, the platelets. To do so switches the focus from the inventive subject matter under consideration to an entirely different matter.

In our findings we focused on what was under consideration. We summarized the defendants' argument (doc. 154, p. 24), the plaintiff's argument (*id.* pp. 29-31), and stated our conclusion at pp. 31-32. There we stated:

> "The sole point of novelty in claims 8-10, therefore, was the language concerning the particle shape. This feature was not disclosed either in the 778 patent nor the prior art considered by the Patent Office prior to allowing claims 8-10 of the 675 patent. We think that feature was disclosed by the Philips Zeitschrift publication, *i. e.*, "platelike particles' with preferential crystal growth along the 'basal planes' so that the 'large dimensions of the crystals [are] in the basal planes and the small dimensions [are] normal to it'. . . . We conclude, after much consideration, that

> this disclosure is virtually identical to the description of particle shapes found in claims 8 through 10 of the 675 patent, *e. g.*, particles 'a substantial portion of [which] have two substantially parallel opposed faces, the distance between which is no greater than the dimension across their faces.' Mr. Blume's experts, whom we find credible, testified as much. . . . Thus, there is no appreciable difference between the disclosure of the pertinent prior art and the claims at issue in the patent in suit."

The foregoing demonstrates that our conclusion resolving the issue in favor of the defendants (*see* doc. 164, p. 25) was on the basis of obviousness.

Furthermore, after extended consideration, we conclude that in the circumstances of this case, even if there was an absence of an enabling disclosure in the prior art, though that would be relevant on the issue of obviousness, it does not *ipso facto* destroy a defense of obviousness. That brings us to a discussion of *Tee-Pak, Inc.* v. *St. Regis Paper Company*, 491 F. 2d 1193 (6th Cir. 1974); *Monroe Auto Equipment Company* v. *Heckethorn Mfg. & Sup. Co.*, 332 F. 2d 406 (6th Cir 1964), and other pertinent cases.

First, we recognize that in *Application of Collins*, 462 F. 2d 538, 542 (CCPA 1972) the Court held that enabling disclosure is relevant not only to the defense of anticipation but also to the defense of obviousness. Defendants say this is only true in chemical cases. However, Collins is not a chemical case so we find defendants' point not well taken. The Court in *Collins* stated:

> "It is well settled, at least in this Court, that a reference which merely *describes* a thing or a process without telling how it is made or carried out does not support a holding of anticipation unless 'a skilled artisan could take its teachings in combination with

> his own knowledge of the particular art and be in possession of the invention,' *In re LeGrice*, 301 F. 2d 929, 936 . . . . 1963 (emphasis omitted) or does not support a holding of obviousness unless 'there is some known or obvious way' to make the thing or carry out the process. *In re Hoeksema*, 339 F. 2d 269, 273, . . . (1968). Thus, we think the lack of a teaching in *Collins* of how to make the presently claimed heat exchangers vitiates the rejection unless there was some known or obvious way to make them." *Collins, supra*, 542-43.

We relied on *Tee-Pak, Inc.* v. *St. Regis Paper Company*, 491 F. 2d 1198 (6th Cir. 1974) in our dismissal of any claims that the Blume 675 was invalid because not novel, *i. e.*, not "anticipated." *Tee-Pak* was an "anticipation" case and that should be borne in mind in considering the language from *Allied Wheel Products* v. *Rude*, 206 F. 2d 752, 766 (6th Cir. 1953), quoted in *Tee-Pak* at page 1198. It is as follows:

> "In order to anticipate an invention, it is necessary that all of the elements of the invention or their equivalents be found in one single description or structure, where they do substantially the same work in substantially the same way."

In our note 1 of the opinion (doc. 164, note 1), we took note of what Judge Phillips said in *Monroe Auto Equipment Company* v. *Heckethorn Mfg. & Sup. Co.*, 332 F. 2d 406 (6th Cir. 1964), a case which was relied on in *Tee-Pak, supra*, concerning the importance of recognizing the distinction between novelty (anticipation) and invention (nonobviousness). Judge Phillips points out at page 414 it is incorrect to say that a patent lacks invention because it is anticipated. "If it is anticipated it lacks novelty; it lacks invention if it would have been obvious." (*Id.*) Judge Phillips continues:

> "From this it should be clear that even though the prior art may not anticipate the patent in question, the disclosures of the prior art may negative invention . . . [cites omitted] that is, a prior device may not be substantially identical to the patented device and therefore cannot anticipate; however, it may be that in the light of this prior device the patented device would have been obvious." (*Id.*, p. 415).

Finally, we are led to suggest that the *dictum* in *Collins* to the effect that proof of an enabling disclosure is necessary to invalidate a patent on grounds of obviousness is unsound, at least in a case such as this. Where we are testing novely under 35 U.S.C. § 102 (b) we look to the prior art for the purpose of showing that the invention was already known. The law requires that the whole invention be found in a single reference. The rationale for this, in our view, is to limit uncertainties in a determination of whether the prior art in fact does teach the invention at hand. We see the enabling disclosure requirement in the same light, as a device for assuring that the invention in fact is to be found in the prior art. It seems particularly applicable where a product patent is being dealt with, especially a chemical compound, for then it seems fair to require, in order that one may say that the invention is not just a concept (*see Hoeksema, supra*) and/or is not new, that the art either must teach how the product be made, or that how it is made is clearly known to those active in the art.

But the same reasoning is not applicable where it is obviousness under 35 U.S.C. § 103, not novelty, which is being tested. Then prior art is resorted to, not to show that the very invention sought to be patented is already known, but for another purpose. Then one examines the prior art to see whether as a matter of fact the inven-

tion would be obvious to one skilled in the art from what is *actually* disclosed in the references. It would be artificial and simply out of place in such a test to impose a requirement on the prior art reference or references that each contain an enabling disclosure.

In sum, as stated above, we find the motion not well taken, and it is denied. Such action is taken without deciding whether the context in which the Court of Customs and Patent Appeals decides cases, namely, reviewing actions of the Patent Office, may make the doctrine of enabling disclosure appropriate, especially in chemical cases, whereas, in the legal context of an infringement suit, the doctrine may be inappropriate.

/s/ DAVID S. PORTER
United States Senior District Judge